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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,046	09/03/2003	Conrad R Schudel	schudel	2045

26496 7590 07/01/2004

GREENBERG & LIEBERMAN
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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/605,046

Applicant(s)

SCHUDEL, CONRAD R

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: Web pages 1, 2.

DETAILED ACTION

This Office action is responsive to communication received 09/03/2003 – application papers filed and Petition to Make Special.

The Petition has been granted. See the communication, mailed 04/27/2004.

Claims 1-18 are pending.

Following is an action on the MERITS:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shira in view of applicant's disclosure regarding the USGA Rules of Golf. The patent to Shira discloses the applicant's basic inventive concept and includes a device for covering the face portion of a golf club. Note, Figure 5 shows a depression (15) that forms the front face of a club. The composite (16) is considered to sit atop the front face and may in fact be fashioned as an insert. The insert, in this case, includes a surface with peaks comprising grains (hard particles, 13) and a fill (soft matrix, 17). As to claims 1-4 and 6, the Shira patent differs from the claimed invention in that the Shira patent does not detail the claimed particle size, specifically the claimed 180 micro-inches. The applicant has detailed in his specification that the USGA Rules of Golf dictate, regarding the surface irregularities on the face, that no peak stand more than 180 micro-inches above the average of the rest of them [0040]. In view of the teaching

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by the USGA presented by the applicant, it would have been obvious to modify the device in the cited art reference to Shira by containing the size of the grains to within 180 micro-inches, the motivation being to make certain that the striking face complies with USGA regulations. As to claim 5, the soft matrix clearly is disclosed as "filling" the space between the grains or hard particles. As to claim 7, the grains or hard particles (13) appear to be small enough to contact the surface of a golf ball. As to claim 8, the soft matrix is considered to be a slurry. As to claim 9, the insert construction suggested by Shira (col. 4, line 58) serves as a carrier. As to claim 10, the fill material outlined supra clearly resists dirt and debris. As to claims 12-15 and 17, as each of the carrier (insert), fill and peaks are formed of diverse materials, these elements are clearly of varying color, one from the other. As to claim 16, the carrier assembly must be strong enough to withstand impact and carry the fill and peaks. As to claim 18, Shira implies that the carrier is of metal construction, since the insert is resistance welded to the head during manufacture.

Claim 4 is objected to because of the following informalities: How can the average height be more than 180 micro-inches when in fact the device has been specified (in claim 1) as requiring that none of the peaks stand more than 180 micro-inches above the average height of the peaks? Appropriate correction is required.

An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows:

Pages 1 and 2 of a web site identified as www.diamond-eagle.com are recognized with

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a Copyright date of 2001. From the information on these two pages, one can discern that a face shield is disclosed which is attachable atop existing grooves on the face of a golf club. Though an exact date is not evident from these two web pages alone, it is noted that the Copyright date is well the filing date of this application. Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the projections on the face in Baker. Rowland ('561) and ('190) include removable pads for the striking surface of a golf club head. Miesch shows a patterned striking face. Caiati and Schrader show attachments for a striking face. Rasmussen includes abrasive particles attached to the striking face.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
June 25, 2004

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